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In re Patent No. 6799732 :
Issue Date: 10/05/2004 :
Application Number: 10/027335 : ON PETITION
Filing Date: 12/19/2001 :
For: WATER SPRINKLER HEAD WITH :
INTEGRAL OFF-ON WATER FLOW :
CONTROL VALVE AND ADAPTIVE :
FITTINGS THEREFOR :

This is a decision in reference to the papers filed on October 30, 2008, which, in view of petitioner's assertion that the delay was unavoidable, are first treated as a petition under 37 CFR 1.378(b),¹ and in the alternative, as a petition under 37 CFR 1.378(c) to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(b) is dismissed.

The petition under 37 CFR 1.378(c) is granted.

The patent issued on October 5, 2004. The first maintenance fee could have been paid from October 5, 2007 through April 7, 2008, or, with a surcharge, from April 7, 2008 through October 5, 2008. The patent expired at midnight on October 5, 2008, for failure to timely pay the first maintenance fee.

Petitioner, *pro se*, states:

When the patent was granted on October 5, 2004, my patent

¹ A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include

(1) the required maintenance fee set forth in § 1.20(e) through (g);

(2) the surcharge set forth in § 1.20(I)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

attorney, Robert Schaap, advised me via a letter dated November 2, 2004, that my first maintenance fee was due 4 years from date of patent issuance, the second fee was due 8 years after and the third fee due 12 years after. I entered those dates onto my patent file so that I would not miss them. Approximately, two months ago in mid-August, I contacted Mr. Schaap's office requesting the information I needed in order to make the payments. (Other than getting e-mails, I am not very computer literate.) He and his secretary assured me they would provide the information. For the next few weeks, I constantly nagged them every 3 or 4 days requesting that info so I could pay the fees. On October 4th, the day prior to the last day, I begged them to please e-mail or call me with that info. I also called Mr. Schaap on October 5th and left pleading messages for him to get back to me.

Just prior to this time, Mr. Schaap's secretary went on part time with Mr. Schaap and took full time employment with another company. Apparently, she handled everything for him. In any event, not until October 8th, did she e-mail me the information that I needed to make my maintenance fee payment and that was 3 days too late. Mr. Schaap himself had no idea where to make the payments, only the secretary knew. As you can see by his November, 2004 letter, he did not even know that the payment was due 3 ½ years after issuance. Up until a few days ago, he even argued with me that the payment was not due without penalty until after 4 years from issuance.

Had my attorney properly advised me that the maintenance fees were due 3 ½ years after issuance instead of four years, this problem would never have arisen because I would have made sure the fees were paid prior to the 3 ½ year mark just to avoid the \$65.00 surcharge, not to mention the \$1,640.00 surcharge. A copy of Mr. Schaap's November, 2004 letter is also enclosed with this letter. Also, find enclosed a copy of the e-mail dated October 8, 2008, from Liliana Zepeda, Mr. Schaap's secretary.

In the present communication, petitioner states that the amount for a petition for unintentional delay is being submitted "but under the circumstances, which were completely unavoidable on my part, it is requested that the Director grant the status of 'UNAVOIDABLE DELAY'." Accordingly, the petition will be treated under both 37 CFR 1.378(b) and 1.378(c).

PETITION UNDER 37 CFR 1.378(b).

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have

been "unavoidable".² A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."³ This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."⁴ Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.⁵ Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.⁶ However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.⁷ In view of In re Patent No. 4,409,763,⁸ this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.⁹ 35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.¹⁰

² 35 U.S.C. § 41(c)(1).

³ Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

⁴ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁵ In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

⁶ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

⁷ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

⁸ 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

⁹ See Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

¹⁰ See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992); Ray v. Lehman, supra.

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.¹¹ That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the second maintenance fee for this patent.¹²

The showing of record has been carefully considered, but does not rise to the level of unavoidable delay.

At the outset, the showing of record is of a failure of communication between petitioner and his counsel regarding the submission of maintenance fees. Petitioner is reminded that the failure of communication between an applicant and counsel is not unavoidable delay.¹³ Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).¹⁴ Moreover, the Office is not the proper forum for resolving a dispute as to the effectiveness of communications between parties regarding the responsibility for paying a maintenance fee.¹⁵

Further, with respect to petitioner's assertion that counsel did not properly assist petitioner in timely submitting the maintenance fee to the USPTO, the U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions.¹⁶ Specifically petitioners' delay caused by the mistakes or negligence of their voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35

¹¹ Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

¹² Id.

¹³ In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

¹⁴ See Ray v. Lehman, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1995).

¹⁵ Id.

¹⁶ Link v. Wabash, 370 U.S. 626, 633-34 (1962).

U.S.C. § 41(c)(1) or 37 CFR 1.378(b).¹⁷ Petitioner was not forced, but rather made a conscious decision to obtain the services of the chosen representative in payment of the maintenance fees for this patent, and therefore must be held accountable for his actions, or lack thereof, before the Office.

As petitioner has not shown that he exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.¹⁸

PETITION UNDER 37 CFR 1.378(c)

This patent expired at midnight on October 5, 2008, for failure to pay the first maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

37 CFR 1.378(c) requires a statement that "the delay in payment of the maintenance fee was unintentional."

It is noted that petitioner states that "the circumstances causing the delay of the maintenance fees was *unavoidable* as opposed to being *unintentional*." (emphasis added). Petitioner is reminded that the "unavoidable" delay and "unintentional" delay standards are not alternatives: an "unavoidable" delay is the epitome of an "unintentional" delay.¹⁹

While the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable, the showing of record is sufficient to establish that the delay until the filing of the instant petition was unintentional.

The statement appearing in the petition varies from the language required by 37 CFR 1.378(c)(3). However, as petitioner has submitted payment in the amount for a petition for acceptance of an unintentionally delayed payment of the maintenance fee, and provided a showing in support of a finding that the delay was unintentional, the statement will be construed as the statement required by 37 CFR 1.378(c)(3). If this is an incorrect reading

¹⁷ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891)

¹⁸ See note 6, *supra*.

¹⁹ See In re Maldaque, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

of the statement appearing in the petition, petitioner must promptly notify the Office.

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Receipt of the change of correspondence address filed with the subject petition is acknowledged. All future correspondence will be mailed to the new address of record. It is further noted that petitioner has asked that the fee address also be changed. Only an address represented by a Customer Number can be addressed as the fee address for maintenance fee purposes. A fee address should be established when correspondence related to maintenance fees should be mailed to a different address than the correspondence address for the application. As it is unknown whether petitioner has obtained a customer number, a Fee Address Indication Form and Request for Customer Number is attached for petitioner's convenience.

Telephone inquiries should be directed to the undersigned at 571-272-3231.



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